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09/552,969	04/20/2000	Scott Dax	ORT-1230	6221

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Audley A Ciamporcero Jr  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003

EXAMINER

LIU, HONG

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 06/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/552,969

Applicant(s)

DAX ET AL.

Examiner

Hong Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 10 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Claims 1-20 and 22 are pending in this application.

This action is in response to the applicants' amendment and reply filed on June 10, 2002.

### **Response to Arguments**

Applicants' arguments filed on June 10, 2002 have been fully considered but they are not persuasive. Rejection of claims under 102(a) is maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

Applicants' election of Group I subject matter with traverse was noted and was not found persuasive for the following reasons. Restriction is proper when there is more than one invention. As stated in the previous action, N-substituted tricyclic rings are different from carbon substituted rings. References anticipating carbon substituted rings would not render obvious of the N-substituted tricyclic compounds. Having a common utility among the groups is not enough where as herein there is not a substantial structure feature common to all groups. They are made and used independently of each other, are not art-recognized equivalents. Such traverse of the restriction requirement is not consistent with applicants' urging of patentability over the art cited below which is much closer to some of the claimed compounds than they in turn are to each other. The compounds of McNally et al. which render the compounds of Group I obvious would not have rendered the compounds of Group II obvious.

For the above reasons, the restriction is still deemed proper and is therefore made FINAL.

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Claims 15-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Because claim 19 was amended to be dependent from claim 15, claim 19 is withdrawn from further consideration along with claim 15.

***Claim Rejections - 35 USC § 112***

The rejection of claims under 35 U.S.C., 112, first paragraph, is hereby withdrawn in view of applicant's amendments and arguments.

The rejection to claims under 35 U.S.C. 112, second paragraph, is hereby withdrawn in view of applicant's amendments.

***Priority***

In the previous Office Action, the provisional application was found to fail to provide adequate support for claims 1-14 of the present application. Applicants argued that the specification on page 30 of the provisional application discloses the compounds where the sulfonamido group is substituted at 2-position. A closer look at Scheme 4 on page 30 reveals that formula XIV has a much narrower scope than formula A of the present application. Formula A has variables such as B1, B2, R2, Y, and Z, which are not describe in the scheme and in claims 15 and 17 of the provisional application. For instance, in claim 4 of the present application, Z is N-(phenyl)sulfonamido. In claim 15, the corresponding R3 is defined as cycloalkyl, naphthyl, or heteroaryl, but not phenyl. Because the subgenus of the provisional application does not provide support for the entire genus of the present application, claims 1-14 are not entitled to the priority filing date.

***Claim Rejections - 35 USC § 102***

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The 102(a) rejection is maintained because the claims of the present application are not entitled to the priority filing date.

***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl

May 29, 2003



Mukund Shah  
Supervisory Patent Examiner  
Art Unit 1624